

REMARKS

Applicants thank the Examiner for his careful examination of the application. Reconsideration and allowance of the application, as amended, is respectfully requested. Claims 10, 12, 18-20, 22-24, 33, 35-36, 42, 44-46, 54-62, 64-67, 71 and 72 remain pending in the application.

Claims 1-9, 11, 13-17, 21, 25-32, 34, 37-41, 47-53, 63, 68-70, and 73 have been canceled.

Claims 10, 12, 18, 20, 24, 33, 35, 36, 42, 46, 54, 62, 66 and 67 have been amended to further clarify applicant's invention.

I. Claim Objections

Claims 9, 24, 32, 46, 53, 66 and 73 have been objected to because of informalities. The Examiner has identified the word "etc." as indefinite. Applicant has amended Claims 24, 46 and 66 to delete the indefinite terms, although Applicant does not believe such terms were indefinite. The remaining Claims 9, 32, 53, and 73 were canceled.

II. Claim Rejections Under 35 U.S.C. § 102(a)

Claims 1-47, 49-54, 56-69 and 71-73 have been rejected as being anticipated by *Alavi*. The Examiner states that *Alavi* teaches all the features of the claims. See Office Action, page 2.

***Alavi* does not teach every claim limitation of claims 10, 33, 54, 67**

Applicant respectfully traverses these rejections on the basis that the Examiner has failed to establish that every element of the rejected claims is present in the *Alavi* reference. A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P § 2131 citing to *Verdegaal Bros. v. Union Oil Co. of California*, 814, F. 2d 628, 631 (Fed. Cir. 1987). It is well settled that when rejecting claims under 35 U.S.C. §102, an Examiner must find that a single prior art reference discloses each and every element of the challenged claim. *In re Donahue*, 766 F.2d 531 (Fed. Cir. 1985); *Getcher v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997).

The invention described by *Alavi* is a system for communication of reporting system reports to users via a web server. *Alavi* does not describe every element found in claims 10, 33, 54 and 67, the independent claims from which the remaining claims depend. Identified below are the specific subsets of Claims 10, 33, 54 and 67 along with the elements not found in *Alavi*.

Claim 10: *Alavi* does not describe application software designed for inclusionary data entry, data retrieval and report generation, wherein said inclusionary data is generated by a patient examination whereby said medical service provider selects data from hierarchical menus to create a full accounting of said patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, physical examination. *Alavi* does not describe report generation being accomplished by accessing a relational database and the inclusionary data stored thereon and wherein the report generation may include a medical report and a billing report. *Alavi* requires a web server and a reporting server. Col. 8, lines 15-29.

Claim 33: *Alavi* does not describe application software designed for inclusionary data entry, data retrieval and report generation, wherein said inclusionary data is generated by a patient examination whereby said medical service provider selects data from hierarchical menus to create a full accounting of said patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, physical examination. *Alavi* does not disclose inputting data into a system or how the particular inclusionary data is entered.

Claim 54: *Alavi* does not disclose inputting inclusionary data into a relational database wherein said inclusionary data is selected from hierarchical menus by said medical service provider to create a full accounting of said patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, and physical

examination. *Alavi* simply discloses accessing the system by a user engine to query the system. Col. 3. lines 14-26. *Alavi* does not disclose inputting data into a system or how the particular inclusionary data is entered.

Claim 67: *Alavi* does not disclose inputting inclusionary data into a relational database wherein said inclusionary data is selected from hierarchical menus by said medical service provider to create a full accounting of said patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, and physical examination. *Alavi* does not disclose inputting data into a system or how the particular inclusionary data is entered. *Alavi* does not disclose processing data, wherein said processing takes information entered by a system user, groups the appropriate elements into a pool of test results and findings.

The examples provided in *Alavi* purport to teach a system for enabling the exchange of business intelligence information over a computer network including at least one client computer system for requesting and receiving the business intelligence information. See Col. 1, lines 57-61. The invention disclosed in the present application is distinguishable from *Alavi* for several reasons which are noted above. Most significantly, *Alavi* does not teach application software designed for inclusionary data entry, data retrieval and report generation, wherein the inclusionary data is generated by a patient examination whereby the medical service provider selects data from hierarchical menus to create a full accounting of the patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, physical examination.

Alavi does not disclose every element of the challenged independent claims 10, 33, 54 and 67 and therefore does not anticipate claims 10, 33, 54 or 67 of the present invention under 35 U.S.C. §102(a). Similarly, dependent claims 12-24, 35-46, 55- 66, 71 and 72 are not anticipated by *Alavi* under 35 U.S.C. §102(a) for failure to disclose each and every element of the challenged claims, as a dependent claim shall be construed to include all the limitations of the claim

incorporated by reference into the dependent claim. M.P.E.P. §608.01(n).

III. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 48, 55 and 70 have been rejected as being unpatentable over *Alavi* in view of U.S. Patent Application Publication 2003/0181790 to *David*. Applicant respectfully traverses this rejection.

The Examiner has failed to establish that *Alavi* and *David* teach or suggest all the limitations of dependant Claims 48, 55 and 70

The Examiner has failed to establish that the combination of *Alavi* and *David* teach or suggest all of the limitations of claims 48, 55 and 70. As stated in 35 U.S.C. §103(a), a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art to which said subject matter pertains. A rejection under 35 U.S.C. §103(a) is authorized whereby it is necessary to combine a single reference with one or more other references to meet the rejected claim. M.P.E.P. §706.02(j). Furthermore, the Examiner must establish a *prima facie* case of obviousness whereby each of three criteria must be met:

1. There must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. There must be a reasonable expectation of success.
3. The prior art reference must teach or suggest all the claim limitations.

In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993); M.P.E.P. §2143.

Claims 48 and 70 have been cancelled. Claim 55 incorporates all of the limitations contained in claim 54. As noted above, *Alavi* fails to teach each and every element of claim 54 and likewise fails to teach or suggest each and every element of claim 55. The combination of *Alavi* and *David* fails to fill in the missing elements which are not taught or suggested by *Alavi*. The combination of the references fails to teach or suggest some of the most significant elements

of Claim 54 and 55, particularly, inputting inclusionary data into a relational database wherein said inclusionary data is selected from hierarchical menus by said medical service provider to create a full accounting of said patient visit and medical history, including but not limited to, detailed hierarchical menus in the areas of patient demographic information, current complaint, findings or diagnosis, past medical history, past surgical history, family history, and physical examination. Accordingly, the combination of *Alavi* and *David* does not disclose each and every element of the challenged independent claim 54, nor dependant claim 55, and therefore does not make claim 54 or 55 of the present invention obvious under 35 U.S.C. §103(a).

CONCLUSION

Applicants submit that this Amendment and Response, if entered, places Claims 10, 12, 18-20, 22-24, 33, 35-36, 42, 44-46, 54-62, 64-67, 71 and 72 in condition for allowance and respectfully requests that such action be taken by the Examiner at this time.

Should a telephone conference be necessary to assist the Examiner's evaluation of this application, a telephone call to the undersigned at (305) 448-7089 is respectfully solicited.

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